REMARKS

This application has been carefully reviewed in light of the Office Action dated August 25, 2005. Claims 1 to 30 are pending in the application, of which Claims 1, 6, 11, 16, 21 and 26 are independent. Reconsideration and further examination are respectfully requested.

Initially, the Examiner refused to consider U.S. Application No. 09/994,865 because the Information Disclosure Statement (IDS) in which it was cited was not accompanied by a Form PTO-1449. Applicant respectfully directs the Examiner's attention to MPEP § 609 which states that a Form PTO-1449 is encouraged but not required when submitting an IDS. Accordingly, Applicants submit that the IDS submitted on February 19, 2002 was properly submitted pursuant to 37 CFR 1.97(b)(3). Although it is not required to list cited U.S. patent applications on a Form PTO-1449, a Form PTO-1449 corresponding to the IDS submitted on February 19, 2002 has been prepared for the Examiner's convenience and accompanies this Amendment. Accordingly, the Examiner is urged to study U.S. Application No. 09/994,865 in its entirety and to form an independent determination of the materiality of that information to the claimed invention. Additionally, the Examiner is requested to indicate that the information has been considered by initialing and returning the Form PTO-1449.

Claims 26 to 30 were rejected under 35 U.S.C. § 101 because the invention allegedly is directed to non-statutory subject matter. Claims 26 to 30 have been amended so that they are now directed to a computer-executable program stored on a computer-readable medium. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this rejection.

Claims 1, 3, 4, 6, 8, 9, 11, 13, 14, 16, 18, 19, 21, 23, 24, 26, 28 and 29 were rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,094,276 (Yamaguchi) in view of U.S. Patent No. 5,901,286 (Danknick). Claims 2, 7, 12, 17, 22 and 27 were rejected under 35 U.S.C. § 103(a) over Yamaguchi in view of Danknick, and in further view of U.S. Patent No. 6,006,281 (Edmunds). Claims 5, 10, 15, 20, 25 and 30 were rejected under 35 U.S.C. § 103(a) over Yamaguchi in view of Danknick, and in further view of U.S. Patent No. 6,020,973 (Levine). Reconsideration and withdrawal of these rejections are respectfully requested.

In regard to the claims, Applicant submits that the Office Action has failed to establish *prima facie* obviousness. The Examiner's attention is respectfully directed to MPEP § 2143.03 which states, in part:

> To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

Therefore, in order to establish that the Claim 1 is obvious over Yamaguchi in view of Danknick, the Office Action must show that all of Claim 1's limitations are taught or suggested by the combination of Yamaguchi with Danknick. Furthermore, all of the words of Claim 1 should considered in

judging the patentability of Claim 1 against the disclosures of Yamaguchi in view of Danknick.

Turning now to specific claim language, original Claim 1 is directed to an information processing apparatus. The information processing apparatus comprises a generation unit adapted to generate, in response to a request from an external apparatus, print data corresponding to a screen displayed on the external apparatus and a transmission control unit adapted to control transmission so that the print data generated by said generation unit is transmitted to a print server.

In contrast to Claim 1, Yamaguchi discloses a digital copier and a scanner/printer server. The digital copier of Yamaguchi is disclosed as having a scanner/printer function. The scanner (digital scanner) has a scanner controller for executing overall control of the scanner. Specifically, an exposure-system controller controls a CCD line sensor so as to scan an original on a platen and converts the scanned image into an analog image signal conforming to the density of each pixel. The analog image signal is converted into an eight-bit digital image signal for each color. The digital image signal is applied to an image processor, which effects a conversion from luminance level to a level corresponding to an amount of toner representing density. Thereafter, the image processor subjects the resulting signal to various processing operations such as mixing, zooming and movement. (See Fig. 2, Lines 1 to 14 of Yamaguchi).

Furthermore, the file server of Yamaguchi is disclosed as including a network controller for controlling protocol processing on a network, a file-server main controller for performing overall control of the file server, such as analysis of the contents of a packet extracted by the protocol, separation of image data, etc., a hard-disk controller for controlling

one or a plurality of hard disks, a hard disk connected to the hard-disk controller, a queue management controller 550 for managing/controlling queuing file data registered in the hard disk, queue table data, which is a table for the management information, a mouse and keyboard used by the manager of the file server to make designations and entries, a keyboard/mouse controller for controlling the mouse and keyboard, a color display for displaying menus, a display memory and a display controller. (See Fig. 1, Fig. 5 and Column 4, lines 13 to 29 of Yamaguchi).

Finally, Danknick discloses that workstations may each comprise a standard workstation capable of generating data files, transmitting them onto A LAN, receiving files from the LAN, and displaying and/or processing such files. A workstation may also have a printer connected directly to it. (See Column 3, Lines 58 to 61 of Danknick). The Network Interface Board (NIB) receives copy data, status requests, and control commands from the LAN, transmits copy data, status requests, and control commands to a copier for execution, and transmits status information back to the LAN. Thus, the NIB can perform not only remote copying services and copy server functionalities, but can also offer to network members whatever status and control features are available from the peripheral interface. (See Column 4, Lines 53 to 57 of Danknick).

Based on the foregoing citations from Yamaguchi and Danknick relied upon in the Office Action, Applicant submits that no permissible combination of Yamaguchi and Danknick teaches or suggests at least one of the limitations of Claim 1, namely, a generation unit adapted to generate, in response to a request from an external apparatus, print data corresponding to a screen displayed on the external apparatus.

In the Office Action, it is alleged that Yamaguchi discloses an information processing apparatus "comprising a generation unit adapted to generate print data and a transmission control unit adapted to control transmission so that the print data generated by the generation unit is transmitted to a print server." The Office Action admits, however, that Yamaguchi fails to expressly disclose that the generation unit is "adapted to generate print data in response to a request and screen displayed from an external apparatus."

The Office Action proposes to remedy the deficiencies of Yamaguchi with the disclosures of Danknick The Office Action states that "data files can be generated and transmitted by an external apparatus over the network to server in a request/response manner." Regardless of the validity such a characterization of the disclosures of Danknick, the Office Action incorrectly characterizes the language of Claim 1 as featuring a generation unit adapted to generate print data in response to "a request and a screen displayed from an external apparatus." The Examiner's attention is respectfully directed to the actual claim language of Claim 1 which features a generation unit adapted to generate, "in response to a request from an external apparatus, print data corresponding to a screen displayed on the external apparatus." Therefore, to remedy the deficiencies of Yamaguchi, Danknick must at least disclose such a feature. Nothing in Danknick does so.

Therefore, the Office Action failed to consider all of the language of Claim 1 when judging the patentablity of Claim 1 against the disclosures of Yamaguchi and Danknick. Because of that failure, the Office Action also failed to establish *prima facie* obviousness of the claimed invention, as the Office Action cannot show that all the claim limitations are taught or suggested by the combination of Yamaguchi and Danknick.

In light of the deficiencies of Yamaguchi and Danknick as discussed above, Applicant submits that Claim 1 is in condition for allowance and respectfully requests same.

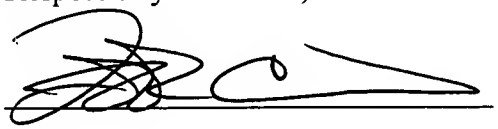
Applicant submits that the discussion from above in regard to Claim 1 applies as well to independent Claims 6, 11, 16, 21 and 26. Accordingly, Applicant submits that Claims 6, 11, 16, 21 and 26 are also now in condition for allowance and respectfully requests same.

The other claims in this application are each dependent from one of the independent claims discussed above and are therefore believed allowable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the allowability of each on its own merits is respectfully requested.

In view of the foregoing amendments and remarks, the entire application is believed to be in condition for allowance, and such action is respectfully requested at the Examiner's earliest convenience.

Applicant's undersigned attorney may be reached in our Costa Mesa, CA office at (714) 540-8700. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,



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